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Harald Gosebruch

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EXAMINER

KELLY, RAFFERTY D

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/534,425	<b>Applicant(s)</b> GOSEBRUCH ET AL.	
	<b>Examiner</b> RAFFERTY KELLY	<b>Art Unit</b> 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-12 and 14-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-12 and 14-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

***Detailed Action***

Amendment filed on 12/19/08 has been acknowledged and entered.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-12, 14-16, 18, and 19-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Durst (Patent No.: US 7,089,420 B1).

Re claim 1, Durst teaches a package, comprising: a material forming the package (58), the material being integral to the package (sealing tape is part of packaging) and including an unlabelled region (no label on the tape), and a mark for identification of the package, wherein the mark comprises a non-predetermined random identifier [53, 54, 60A] comprising at least one integral feature of the material forming the package, wherein the non-predetermined random identifier is peculiar to the material, and is located in the unlabelled region (sealing/security tape 58 is “unlabelled”) of the material (Fig. 6, Fig. 7A-B, Fig. 9, col. 45, lines 11-63).

Re claim 19, Durst teaches a method of creating a marking for a package provided with a mark, comprising the steps of: detecting a mark comprising a non-predetermined random identifier [53, 60A, 83] located on an unlabelled region of a

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material that forms the package (sealing/security tape 58 is unlabelled) and is integral to the package (sealing tape is part of the packaging), the non-predetermined random identifier comprising at least one integral feature of the material, wherein the non-predetermined random identifier is peculiar to the material, converting the non-predetermined random identifier to the marking [54, 60A with grid 200], and depositing the marking as at least one of a data record in a data bank or a print on the package (Fig. 6-7B, Fig. 9, association by code, [56, 55, 59, 62, 63], and stored in database, col. 45, lines 11-63, col. 46, lines 4-41).

Re claim 31, Durst teaches a method for the identification of a package provided with a mark located on an unlabelled (sealing tape 58 is not labeled) region of a material that forms the package and is integral to the package (tape 58 is part of the packaging), the mark comprising a non-predetermined random identifier [53, 54, 60A] that comprises at least one integral feature of the material, wherein the non-predetermined random identifier is peculiar to, and wherein a marking, which is a function of the mark, is printed on the package or filed as a data record in data bank (Fig. 6, Fig. 7A-B, Fig. 9, col. 45, lines 11-63, col. 46, lines 32-40), the method comprising steps of: detecting the random identifier, converting the random identifier to an associated marking, and aligning the associated marking with the print of the marking on the package, or the a data record of the marking filed in a data bank (Fig. 6-7B, Fig. 9, association by code, [56, 55, 59, 62, 63], and stored in database, col. 45, lines 11-63, col. 46, lines 4-41, and col. 31, line 25-col. 32, line 8. Further it could also be considered that the 'alignment' pattern is the relation of the fibers [60A] to the grid pattern [200] and stored in the

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database and identified and looked up by the barcode [62, 63], Fig. 7B, col. 45, lines 31-42, col. 46, lines 32-41).

Re claim 37, Durst teaches a device for creating a marking for a package provided with a mark located on an unlabelled region (tape 58 is not labeled) of a material that forms the package and is integral to the package (tape 58 is part of the package), comprising: means for detecting the mark, the mark comprising at least one non-predetermined random identifier comprising at least one integral feature of the material, wherein the non-predetermined random identifier is peculiar to the material, means for generating and displaying or outputting the marking based on the random identifier, and means for at least one of filing or depositing the marking (random fibers forms pattern, which in turn is imaged and converted and then stored in database in association to another code also present on the article, col. 31, line 25- col. 32, line 8, col. 45, lines 11-63, database, col. 46, lines 32-41).

Re claim 43, Durst teaches a device for the identification of a package including a mark located on an unlabelled region of a material that forms the package and is integral to the package (58 is unlabelled and part of the package), the mark comprising a non-predetermined random identifier that comprises at least one integral feature of the material, wherein the non-predetermined random identifier is peculiar to the material, and wherein a marking is related that is a function of the non-predetermined random identifier, the device comprising: means for detecting (col. 43, lines 12-20) the random identifier peculiar to the package itself, and means for generating and displaying or outputting an associated marking based on the random identifier, wherein the

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associated marking is associated with the marking created as a function of the non-predetermined random identifier (Fig. 6-7B, Fig. 9, can be interpreted as a marking [54] is a function of the randomly dispersed fibers [53] col. 45, line 11- col. 46, line 17, or can be interpreted as the marking [54] is imaged to provide raster to vector conversion, the compressed image is output and stored in a database for later comparison, col. 31, lines 25-67).

Re claim 3, Durst teaches the random identifier comprises a part of a design of the package (because the random identifier exists on the package it is part of the design of the package, col. 45, lines 11-42, also, the random identifier is in the graphic image, Fig. 9, col. 45, lines 53-63).

Re claim 4, Durst teaches the random identifier comprises at least one random pattern (col. 45, lines 11-63).

Re claim 5, Durst teaches the random pattern comprises a distribution of luminophores (col. 45, lines 11-63, col. 4, lines 5-18, col. 30, lines 63-67).

Re claim 6, Durst teaches marking generated based on the random pattern and arranged on the package (Fig. 6, Fig. 7A-B, Fig. 9, col. 45, lines 11-63).

Re claim 7, Durst teaches the distribution of luminophores is detectable and is at least one of filed or deposited as an optionally coded marking in at least one of a data bank or print on the package (col. 4, lines 5-18, Fig. 7A-B, col. 45, lines 11-42, col. 30, lines 63-67).

Re claim 8, Durst teaches a code [56, 55, 59, 62, 63] applied to the package (Fig. 6, Fig. 7A-B, col. 45, lines 11-42).

Re claim 9, Durst teaches the code includes a serial number and is in a predetermined and reproducible relationship to the mark (Fig. 6 [52] is a numerical representation of code [56, 55], which correspond to the random pattern, col. 45, lines 11-42).

Re claim 10, Durst teaches the code and mark are in correlation with each other (Fig. 6 [52] is a numerical representation of code [56, 55], which correspond to the random pattern, col. 45, lines 11-42).

Re claim 11, the correlation is formed by storage (correlation by storage of printed code, col. 45, lines 11-30, correlation by database, col. 46, lines 32-41. The instant application defines storage, "The storage can be formed as print on the package 10 or in an external data bank," on page 10 of the specification).

Re claim 12, Durst teaches the correlation is formed by a coding function (Fig. 6, code [56, 55] corresponds to the random pattern, col. 45, lines 11-42).

Re claim 14, Durst teaches the random identifier is arranged on the whole package or in a predefined region of the package (Fig. 6, Fig. 7A-B, Fig. 9, col. 45, lines 11-63).

Re claim 15, Durst teaches the package further comprises at least one of a primary packaging, or a secondary packaging, or a tertiary packaging (Fig. 7A-B, col. 45, lines 21-42).

Re claim 16, Durst teaches at least one of the mark, the code or the marking is visibly arranged on at least one of the primary packaging, the secondary packaging, or the tertiary packaging (Fig. 7A-B, col. 45, lines 21-42).

Re claim 18, Durst teaches wherein the random pattern comprises a gap width (pattern 60A has gaps with certain widths).

Re claim 20, Durst teaches providing the package with a random pattern as the random identifier, the random pattern including a distribution of luminophores (col. 45, lines 11-63, col. 4, lines 5-18, col. 30, lines 63-67).

Re claims 21 and 33, Durst teaches converting step comprises performing a suitable mathematical function (the random distribution of fibers forms a random pattern, and the pattern is imaged and converted to vector encoded data, during the authentication process a the random code is imaged and converted to appropriate vector format and an appropriate file of the ideal vector image is looked up in the database via the barcode on the document and the two are compared, col. 31, line 25- col. 32, line 8).

Re claim 22, Durst teaches the depositing step comprising coding the marking before printing on the package or before filing in the data bank (the random identifier pattern formed by the markings of fibers must be first deposited before the representative image can be stored in the database, this is because the identifier is random, so if it was stored first, than it would be a predetermined pattern, col. 31, line 25- col. 32, line 8).

Re claim 23, Durst teaches the marking is deposited in the data bank, and further compressing the marking before filing in the data bank (col. 31, line 25- col. 32, line 8).

Re claim 24, Durst teaches the detecting step comprises optically detecting the random identifier (col. 31, line 25- col. 32, line 8).



Re claim 25, Durst teaches numerically coding [52] the random distribution of luminophors [54] (random distribution is associated with barcode and barcode number representation, Fig. 6, col. 45, lines 11-20), the luminophores being visible with UV light (col. 28, lines 14-19, col. 30-35-51), and storing the numerically coded luminophores as the random identifier (read barcode/numerical code, col. 45, lines 11-20, look up in database, col. 46, lines 32-41).

Re claim 26, Durst teaches providing the package with a code [56, 55, 59, 62, 63] (Fig. 6-7B, Fig. 9, col. 45, lines 11-63).

Re claim 27, Durst teaches combining the code and the marking into a data pair, wherein at least two of the code, the mark and the marking have a predetermined, reproducible reference relationship to each other (random pattern [54, 60A] formed by the distribution of random fibers is associated with barcode [55, 56, 52, 59, 62, 63] are stored in the database, Fig. 6-7B, col. 45, lines 11-63, col. 46, lines 4-17, lines 32-41. Further it could be considered that the combination pattern is the relation of the fibers [60A] to the grid pattern [200] and stored in the database and identified and looked up by the barcode [62, 63], Fig. 7B, col. 45, lines 31-42, col. 46, lines 32-41).

Re claim 28, Durst teaches correlating the marking and the code with each other in the data pair, and filing the data pair in the data bank (random pattern [54, 60A] formed by the distribution of random fibers is associated with barcode [55, 56, 52, 59, 62, 63] are stored in the database, Fig. 6-7B, col. 45, lines 11-63, col. 46, lines 4-17, lines 32-41. Further it could be considered that the combination pattern is the relation of

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the fibers [60A] to the grid pattern [200] and stored in the database and identified and looked up by the barcode [62, 63], Fig. 7B, col. 45, lines 31-42, col. 46, lines 32-41).

Re claim 29, Durst teaches at least one of the code, the mark, or the marking is applied or attached to the package either on-line or off line (encompasses all possibilities and therefore is met by Durst, though in col. 31, lines 25-51 the storage of the reference image appears to be on-line because it needs to be stored in the database).

Re claim 30, Durst teaches the package comprises the at least one of a primary packaging, a secondary packaging, or a tertiary packaging; and at least one of the code, the mark, or the marking is applied or attached to at least one of the primary packaging, the secondary packaging, or the tertiary packaging (Fig. 7A-B, col. 45, lines 21-42).

Re claim 32, Durst teaches rendering the random identifier visible by irradiation with light in the ultraviolet spectral range (col. 28, lines 14-19, col. 30, lines 35-51); and optically detecting the random identifier (col. 31, line 25- col. 32, line 8).

Re claim 34, Durst teaches the detecting step comprises scanning the random identifier to obtain identifier information (col. 45, lines 11-63), the converting step comprises determining the associated marking from the scanned identifier information and the aligning step comprises comparing the associated marking with the marking (col. 46, lines 4-42, col. 31, line 25-col. 32, line 8).

Re claim 35, Durst teaches detecting a code arranged on the package (col. 45, lines 11-63).

Re claim 36, Durst teaches forming an associated data pair comprising the detected code and the associated marking, and comparing the associated data pair with a data pair comprising the code and the marking previously filed in the data bank (the random distribution of fibers forms a random pattern, and the pattern is imaged and converted to vector encoded data, during the authentication process a the random code is imaged and converted to appropriate vector format and an appropriate file of the ideal vector image is looked up in the database via the barcode on the document and the two are compared, col. 31, line 25- col. 32, line 8).

Re claim 38, Durst teaches a means for providing the package with the random identifier (code is printed, col. 31, lines 29-33, printing process, col. 32, lines 55-67).

Re claim 39, Durst teaches the means for at least one of filing or depositing comprises at least one of a printer or a data bank (database stores authentication data, col. 46, lines 32-41).

Re claim 40, Durst teaches means for applying the marking to obtain the code (apply fibers to package via printing, which together are the code, col. 31, line 25-67, or apply code to database, col. 46, lines 32-41).

Re claim 41, Durst teaches means for coding the marking to obtain the code (the random distribution printed forms the code, col. 45, lines 11-63, or rather, the random distribution pattern is also converted to vector form and compressed and stored in the database, col. 31, line 25-col. 32, line 8).

Re claim 42, Durst teaches the means for detecting, the means for generating and displaying or outputting the marking, the means for coding and the means for at

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least one of depositing or filing, are operatively linked together (Fig. 1, col. 43, lines 12-20, further communicates with database, col. 46, lines 32-42, further, the initial forming and storage of the representative data of the random pattern is stored for later comparison and therefore is also connected to the database, col. 31, line 25- col. 32, line 8).

Re claim 44, Durst teaches means for detecting is operative to emit UV light and pick up information from the random identifier which is rendered visible (col. 28, lines 14-19, col. 30, lines 35-51, col. 31, line 25- col. 32, line 8).

Re claim 45, Durst teaches means for detecting is further operative to detect information relating to the marking [54, 60A] and a code [52, 56, 55, 59, 62, 63] located on the package (Fig. 6-7B, col. 43, lines 12-20, col. 45, lines 11-42).

Re claim 46, Durst teaches means for generating and displaying or outputting is operative to carry out a mathematical function to convert the random identifier to the associated marking (random pattern is stored in compressed form for latter use in authentication procedure, col. 31, line 25- col. 32, line 8).

Re claim 47, Durst teaches means for decoding the marking (conversion for authentication, col. 31, line 25-col. 32, line 8, imaging/scanning, col. 43, lines 12-20, col. 45, line 11- col. 46, line 41).

Re claim 48, Durst teaches means for detecting, the means for generating and displaying or outputting, and the means for decoding are coupled to a data bank (Fig. 1, col. 73, lines 12-20, detection of the random pattern and coded pattern are done via the

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camera and barcode reader and then the compared to the record in the database, col. 46, lines 32-41).

Re claim 49, Durst teaches means for detecting, the means for generating and displaying or outputting, the data bank, and the means for decoding are operatively linked to each other (Fig. 1, col. 43, lines 12-20, col. 46, lines 32-41).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Durst (Patent No.: US 7,089,420 B1).

Re claim 50, Durst fails to disclose a mobile hand-held device comprising the device according to claim 43.

However Durst teaches the barcode scanner is hand-held (Fig. 1, col. 42, lines 8-12).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Durst such that the authentication system is embodied in a hand held for so that it is mobile so that it is quick and easy for an operator to use (Durst, col. 2, lines 30-45).

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4. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Durst (Patent No.: US 7,089,420 B1) as applied to claim 16 above, and further in view of Komiya (US Patent No.: 6,155,025). The teachings of Durst are disclosed above.

Re claim 17, Durst fails to teach the marking is arranged on the secondary packaging, the marking being designed as a link number, wherein the link number is generated from at least one of the mark, the code, or the marking arranged on the primary packaging.

Komiya teaches a code arranged on a secondary packaging, designed as a link number, wherein the link number is in relationship to the code on the primary packaging (col. 22, lines 39-55).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Durst with Komiya for adding the ability to track the packaged items at any of the unpacking levels of the product and therefore be able to better trace the product (col. 22, lines 56-64).

### ***Response to Arguments***

Applicant's arguments filed 12/19/08 have been fully considered but they are not persuasive.

Regarding the argument that Durst et al. does not teach the mark comprising at least one integral features of the package, this argument is not found to be persuasive. Applicant argues that the sealing tape 58 of Durst et al. is adhered to the package and therefore not an integral feature of the material forming the package. However, the sealing tape is being interpreted by the examiner as being part of the material forming

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the package (Col. 45 Lines 21-23). Using this interpretation, the sealing tape is integral to the package and the mark comprises at least one integral feature (shape, length, size, etc) of the material forming the package.

Regarding the argument that Durst et al. does not teach the mark being in the unlabelled region of the material, this argument is not found to be persuasive. Using the above interpretation, sealing tape 58 is part of the package and this piece of the package does not have a label on it.

Finally, regarding the argument that Durst et al. does not teach the numerous advantages of the invention of the present application, this argument is not found to be persuasive. The various advantages presented by the applicant are not implied or required by the claim and therefore do not define the present invention over the prior art.

The rejection of claim 18 has been updated as a result of the amendment removing "cut edges" from the claim.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAFFERTY KELLY whose telephone number is (571)270-5031. The examiner can normally be reached on Mon. - Fri. 800-1730 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rafferty Kelly/  
Examiner, Art Unit 2876  
4-8-09

/Michael G Lee/



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Supervisory Patent Examiner, Art Unit 2876